REMARKS

This Amendment responds to the Office Action mailed on October 26, 2005. In the Office Action, the Examiner:

- admitted that the amended claims submitted in the previous Amendment, dated August 16, 2005, have overcome the rejections raised by the Examiner in the previous Office Action, dated May 25, 2005;
- expanded the search to a non-elected species, *i.e.*, an aliphatic dialdehyde compound;
- rejected claims 1-5, 9, 13 and 17 under 35 U.S.C. § 102(b) as being anticipated by Johnson *et al.* (U.S. Patent No. 5,354,788);
- rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Johnson *et al.*; and
- withdrew claims 7, 8, 10-12, 14-16 and 18-25 from consideration.

Applicants would like to express gratitude to the Examiner for the courtesy extended to Applicants' attorney during a telephone interview on November 9, 2005. During the interview, the Examiner indicated (1) the rejections raised in the May 25, 2005 Office Action are based on the examination of the first species of Group I; and (2) the instant rejections are based on the examination of the third species of Group I. The two species are specified at page 3 of the Office Action, dated April 5, 2005. Further, the Examiner indicated that if the instant rejections are overcome, the claims drawn to the two species will be rejoined. The patentability of the rejected claims in light of the cited reference was discussed. But no agreement was reached.

Claim 1 is amended to more specifically define and distinctly claim the subject matter by improving some formalities and specifying that step (b) of claim 1 occurs in the presence of an acid catalyst. The amendment is supported by the specification, for example, in paragraph [29] at page 12. No new matter is added by this Amendment. After entry of this Amendment in response to the instant Office Action, the pending claims are: claims 1-6, 9, 13 and 17.

Response to Claims Withdrawn by the Examiner

Claims 7, 8, 10-12, 14-16 and 18-25 were withdrawn by the Examiner with traverse. Applicants respectfully submit that the withdrawn claims, particularly claims 7-8, 10-12, and 14-16, can be examined without undue burden. Further, claim 16 is drawn to the same aliphatic dialdehyde species as claims 1-6, 9, 13 and 17. See [12] at pages 4-5 of the specification.

In view of the above comments, Applicants respectfully request (1) reconsidering claim 16 as a claim belonging to the same group as claims 1-6, 9, 13 and 17; and (2) rejoining all the claims, particularly claims 1-17.

Response to Rejections Under 35 U.S.C. § 102(b)

Claims 1-5, 9, 13 and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Johnson *et al.* (U.S. Patent No. 5,354,788). The Examiner indicated that (1) Johnson *et al.* discloses a process for preparing phenolic resole resin comprising the steps of (a) reacting from about 0.05 to about 0.3 moles of a dialdehyde per mole of phenolic compound under acid conditions, and (b) subsequently reacting the products of step (a) with from about 0.4 mole to about 2.8 moles of formaldehyde.

The Applicants respectfully submit that Johnson *et al.* teaches that step (b) is performed under basic conditions. See Col. 2, lines 62-63 of U.S. Patent No. 5,354,788. Further, claim 1 is amended to more specifically define and distinctly claim the subject matter by adding the recitation of "in the presence of the acid catalyst" in step (b). Therefore, the currently amended claim 1 is not anticipated by Johnson *et al.* because Johnson *et al.* does not disclose all elements of claim 1, particularly the presence of an acid catalyst in step (b). Because claims 2-5 and 9, 13 and 17 depend on claim 1, they are also not anticipated by Johnson *et al.* as well.

In view of the above comments, Applicants respectfully request withdrawal of the rejections of claims 1-5, 9, 13 and 17 under 35 U.S.C. 102(b) as being anticipated by Johnson *et al.* (U.S. Patent No. 5,354,788).

Response to Rejections Under 35 U.S.C. § 103(a)

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson *et al.* (U.S. Patent No. 5,354,788). The Examiner indicated that Johnson *et al.* discloses a process for preparing phenolic resole resin as stated above. The Examiner has admitted that Johnson *et al.* does not disclose the claimed temperature range of between

about 120 °C and about 150 °C. However, the Examiner asserted that because Johnson *et al.* discloses the temperature range of from about 95-105 °C, it would have been obvious to one of ordinary skill in the art to raise the temperature range from about 95-105 °C to about 120-150 °C.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457-58 (Fed. Cir. 1998). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness because (1) Johnson *et al.* fails to teach or suggest all the claim elements of claim 6 and (2) Johnson *et al.* teaches away from the invention.

Claim 6 depends on claim 1. Claim 1 is amended to more specifically define and distinctly claim the subject matter by adding the recitation of "in the presence of the acid catalyst" in step (b). Applicants respectfully submit that Johnson *et al.* does not teach or suggest all the claim elements of currently amended claim 1, particularly the presence of an acid catalyst in step (b) and the claimed temperature range of "between about 120 °C and about 150 °C." Further, Johnson *et al.* teaches away from the invention because Johnson *et al.* teaches that step (b) is performed under basic conditions whereas step (b) of claim 1 occurs under acidic conditions. Therefore, claim 1 and thus claim 6, which depends on claim 1, are not obvious over Johnson *et al.*

In view of the above comments, Applicants respectfully request withdrawal of the rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Johnson *et al.* (U.S. Patent No. 5,354,788).

CONCLUSION

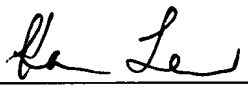
In light of the above amendments and remarks, the Applicants respectfully request that the Examiner reconsider this application with a view towards allowance.

No fee is believed due for this submission. However, if any fees are required for the entry of this paper or to avoid abandonment of this application, please charge the required fees to Jones Day Deposit Account No. 50-3013.

The Examiner is invited to call the undersigned attorney at 858-314-1123, if a telephone call could help resolve any remaining items.

Respectfully submitted,

Date November 10, 2005



Kam W. Law (Reg. No. 44,205)

JONES DAY
12750 High Bluff Drive, Suite 300
San Diego, CA 92130-2083
(858) 314-1123

For: Benjamin Bai (Reg. No. 43,481)

JONES DAY
717 Texas Avenue, Suite 3300
Houston, TX 77002-2712
(832) 239-3816